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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,534	05/02/2001	Peter Van Horne	CISCO-4667	6599

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EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,534

Applicant(s)

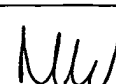
VAN HORNE ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-82 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 39-82 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5-2-01</u> . | 6) <input type="checkbox"/> Other: ____. |

Status of Claims

1. Claims 39-82 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 39-54, 58-73, 77, 78, 80 and 81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claims 39, 43, 46, 50, 58, 62, 65, 69, 77, 78, 80 and 81 recite conditional language. Claims 39, 46, 58, 65, 78, 80, and 81 recite "if an approve signal is provided", while claims 43, 50, 62, and 69 recite the Applicant's system performing specific actions "if the client system has proper network configuration and registry settings to accomplish communication with the electronic network". Conditional language inherently comprises at least two conditions: the "if" and the "if not". The Applicant's claims, however, are silent regarding how Applicant's system

is to perform if the “if not” condition holds. Therefore, one of ordinary skill is hindered from determining the scope and how to use said system.

For purposes of examination, with regard to these claims, the Examiner is considering the “if not” case. For example, claims 50, 62, and 69 recite performing particular steps “if the client has proper network configuration and registry settings to accomplish communication with the electronic network”. However, that is predicated on the client receiving an “approval signal” (see claims 39, 58, 65). As stated above, the Examiner is considering the “if not” case therefore, a rejection signal is received and therefore, claims 50 and 62 do not occur.

Claims 40-42, 44, 45, 47-49, 51-54, 51-57, 59-61, 63, 64, 66-68, and 70-73 are also rejected because they depend from claims 39, 43, 46, 50, 58, 62, 65 or 69.

b. Claims 39, 46, 58, 65, 77, 78, 80 and 81 are also rejected because they recite a client-side processor performing two-way communications if an approve signal is received by a server. However, because the client exchanges (i.e. sends and receives) data with a server, the client is performing “two-way” communications at least with said server. Therefore, to one of ordinary skill, it is not clear how the Applicant’s system is to perform if the approve signal is not received.

c. Claim 44 recites "sending a periodic signal connect signal to the server system confirming that the client system is still connected".

However, claim 39, from which claim 44 depends, does not refer to the client system making a "connection". Claim 63 recites a similar limitation.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 39, 43-46, 50-52, 54, 65, 69-71, 73, 77, 78, 80, and 81 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Budow et al., U.S. Patent No. 5,661,517.

As per claims 39, 43-46, 50-52, 55, 65, 69-71, 77, 78, 80, and 81, Budow teach client-server communication system comprising:

- specifying a billing preference chosen from a set of billing options that include at least one technique for making a monetary payment (figures 7A-8C)
- transmitting said billing preference to the server system (figures 7A-8C; column/line 12/7-13/10; column/line 24/52-25/28; column 28, lines 30-54)
- receiving a reject or temporary approve signal (or inquiry) from the server system (figures 7A-8C; column 25, lines 28-31, 45-52 and 63-67; column 26, lines 10-13; column 27, lines 10-36)
- a database for storing data, following disconnection of the client system, that identifies each client system, billing information representing an amount of monetary charges accumulated (e.g. data that represents connect time) by said client system (column 7, lines 6-15; column 13, lines 10-13 and 47-49)
- transmitting a rejection from the server system to the client (figures 7A-8B)
- sending periodic connect signals to the server to confirm a connection (column 11, lines 34-65; column 14, lines 4-13; column 24, lines 40-51)

As per claims 54 and 73, Budow et al. teach receiving a periodic connect

signal (i.e. polling response signal to determine if a user is watching a pay-per-view event), providing a clock signal (e.g. polling every two seconds, free preview of event for a limited time such as the first 5 minutes, duration of event, system computer's internal timing mechanism), determining if said periodic signal (i.e. polling signal) is received from the client system within a pre-determined time period based on said clock signal (i.e. after the allotted time for free viewing) and setting a disconnect parameter (i.e. not processing a bill) if it is determined that said periodic signal (i.e. polling response from client) has not been received from the client within said predetermined period- "no data" or "data" signal is received during the free period (i.e. not received within said predetermined period) (column 11, lines 34-65; column 14, lines 4-13; column 24, lines 40-51).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 40-42, 48, 49, 53, 55-57, 72, 74-76, 79 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budow et al., U.S. Patent No. 5,661,517.

As per claims 40-42, 48, 49, 67, and 68, "software" is a computer program that makes hardware work (Microsoft Press "Computer Dictionary" Third Edition, page 441). Examples are "system software" that controls the working of a computer and "network software" which enables groups of computers to communicate". Budow et al. teach a client system in communication with a server, where said client system comprises a terminal, television or a terminal-television combination (figure 1; column 14, lines 56-60). The terminal comprises a processor, memory and other hardware devices (figures 4 and 4A). The terminal processes polling data (column 11, lines 40-46; column 14, lines 4-23) and billing data (column 15, lines 26-33; column 21, lines 6-18), and controls reception to the television and interactive services by providing a user with an interface to the server and server applications (column 7, lines 22-38; column 13, lines 50-55). Hence, it is inherent that the Budow et al. terminal (figures 4 and 4A) and system includes software. Further, "pushing" data and "updating" software are old and well-known. Therefore, it would have been obvious to one of ordinary skill to "push" updates from the server (figure 1, item 4) to the plurality of room terminals in order to expedite the process.

As per claims 53 and 72, Budow et al. teach maintaining a customer portfolio (column 13, lines 10-13) in order to settle a user's bill which includes client identification information (column/line 28/64-29/3). When using a card to settle the bill a hotel processes the checkout by transmitting account billing

corresponding to the total amount of monetary charges to the customer's credit card company (i.e. network management system) in order to complete the transaction.

As per claims 55-57, 74-76, 79 and 82, Budow et al. teach providing a set of billing options to a user, receiving a billing preference and sending an approval inquiry to a remote approval system (column/line 26/43-27/58). Budow et al. also teach conducting two-way communications over an electronic network (figure 1 and 7A-8B) and a server receiving a rejection signal from a remote approval system and transmitting a rejection signal from the server to the client (figures 7A-8B; column/line 26/43-27/58). Regarding temporary approval signals, Budow et al. allow users to preview pay-per-view selections (column 11, lines 46-65) therefore, the Budow et al. system sends a "temporary approval signal" to the client system prior to the server system receiving the results from the remote approval system. If the user receives an "insufficient funds" message then, it would have been obvious for a user to no longer seek the ability to view the pay-preview event, and thus discontinuing two-way communications (figures 7A-8B) between client and server (i.e. server discontinues communications with client). On the other hand, Budow et al. allows for a user to use another card (i.e. additional billing information) if the initial card lacks sufficient funds (claims 57 and 76) (column/line 26/61-27/8).

8. Claims 47 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budow et al., U.S. Patent No. 5,661,517 in view of Lewis, U.S. Patent No. 5,612,730.

As per claims 47 and 66, Budow et al. teach a system for providing interactive and information services to users staying at a hotel (column 13, lines 50-53). However, Budow et al. do not specifically recite the internet. Lewis teaches a system for providing information services such as access to the internet to users staying at a hotel (column 5, lines 15-21; column 6, lines 14-23; column 7, lines 10-36; column 8, lines 36-50). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Budow et al. and Lewis in order to generate additional revenue streams for providing access to the internet.

9. Claims 58-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budow et al., U.S. Patent No. 5,661,517 in view of Ahmad, U.S. Patent No. 5,565,908.

As per claims 58 and 62-64, Budow et al. teach a client system in communication with a server, where said client system comprises a terminal, television or a terminal-television combination (figure 1; column 14, lines 56-60) and said terminal sends periodic connect signals to the server to confirm a

connection (column 11, lines 34-65; column 14, lines 4-13; column 24, lines 40-51) and receives temporary approval signals (figures 7A-8B; column 11, lines 46-65). The terminal comprises a processor, memory and other hardware devices (figures 4 and 4A). However, Budow et al. do not teach explicitly recite volatile RAM. The RAM of Budow et al. is non-volatile and reserved exclusively for billing. Ahmad teaches a client system comprising a terminal and TV wherein the terminal comprises volatile RAM associated with a processor (column 6, lines 58-67). Therefore, it would have been obvious to one of ordinary skill to modify the terminal of Budow et al. ('517, figures 4 and 4A) by using the processor board of the Ahmad terminal, in order to more efficiently process data by allowing the processor ('517, figures 4 and 4A) to temporarily store data in the RAM ('908, column 6, lines 65-67) and use EPROM to store control programs for the processor ('908, column 6, lines 65-68).

As per claims 59-61, Software is a computer program that makes hardware work (Microsoft Press "Computer Dictionary" Third Edition, page 441). Examples are "system software" that controls the working of a computer and "network software" which enables groups of computers to communicate". Budow et al. teach a client system in communication with a server, where said client system comprises a terminal, television or a terminal-television combination (figure 1; column 14, lines 56-60). The terminal comprises a processor, memory and other hardware devices (figures 4 and 4A). The terminal processes polling

data (column 11, lines 40-46; column 14, lines 4-23) and billing data (column 15, lines 26-33; column 21, lines 6-18), and controls reception to the television and interactive services by providing a user with an interface to the server and server applications (column 7, lines 22-38; column 13, lines 50-55). Hence, it is at least obvious that the Budow et al. terminal (figures 4 and 4A) includes software. Further, “pushing” data and “updating” software are old and well-known. Therefore, it would have been obvious to one of ordinary skill to “push” updates from the server (figure 1, item 4) to the plurality of room terminals in order to expedite the process.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Sistanizadeh et al. teach assigning and leasing an IP address to a customer terminal on an hour, day, month or permanent basis
- Mettke teaches a “pay-as-you-use” telecommunications terminal
- Rodwin et al. teach dynamically assigning an IP address to a user terminal
- Edwards et al teach disclose a system for providing users with a free preview of a pay-per-view or subscription based content

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

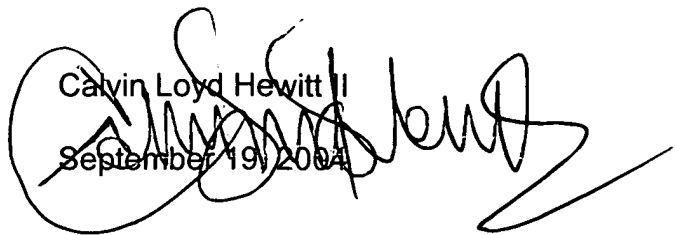
Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

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Calvin Loyd Hewitt II
September 19, 2004

A handwritten signature in black ink, appearing to read "Calvin Hewitt", is written over the printed name and date. The signature is stylized with a large initial "C" and a long horizontal stroke at the end.